

### REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on December 17, 2003, and the references cited therewith.

No claims are amended, canceled or added; as a result, claims 30-51 remain pending in this application.

#### Double Patenting Rejection

Claim 39 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,078,312. Applicant will address the double patenting rejection upon resolution of the anticipation and obviousness rejections below.

#### §102 Rejection of the Claims

Claims 32-33, 40 and 51 were rejected under 35 USC § 102(b) as being anticipated by Pettypiece, Jr. (U.S. 5,223,709). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully traverses the rejection and submits that the Office Action did not make out a *prima facie* case of anticipation because Pettypiece does not disclose each and every element of Applicants claimed invention.

For example, claim 32 recites “a first gradient having a plurality of positions uniquely varying in intensity level of a first color” and “a second gradient having a plurality of positions uniquely varying in intensity level of a second color.” Applicant has reviewed Pettypiece and

can find no teaching or disclosure of a first gradient having a first color and a second gradient having a second color as arranged in Applicant's claim 32. Pettypiece discloses a sphere having three areas 50, 52 and 54 that provide varying shades of gray. Thus at best, Pettypiece discloses three gradients of a single color, each covering a relatively small portion of the sphere. This is unlike Applicant's claimed invention, in which a gradient having two colors, a first and second color is used. As a result, Pettypiece does not teach or disclose each and every limitation of Applicant's claim 32. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 32.

Claim 33 depends from claim 32, and therefore inherits the elements of claim 32 while adding further patentable distinctions. Claim 33 is therefore not anticipated by Pettypiece for the same reasons as discussed above with respect to its base claim 32. Applicant respectfully requests the withdrawal of the rejection of claim 33.

Claims 40 and 51 each recite that the first and second gradient "substantially cover the surface." As discussed above, the three areas 50, 52 and 54 in Pettypiece each only covers a relatively limited portion of the spherical surface. As a result, Pettypiece does not teach or disclose each and every element as arranged in Applicant's claim 40. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 40 and 51.

Claims 30-31, 40-42, 46, 49 and 51 were rejected under 35 USC § 102(b) as being anticipated by Joyce (U.S. 4,686,329). Applicant respectfully traverses the rejection because Joyce does not teach or disclose each and every element of Applicant's claims.

For example, claim 30 recites "a mouse pointing device positionable over a surface having a plurality of uniquely coded positions arranged in a gradient substantially covering the surface." Claim 31 also recites "uniquely coded positions arranged in a gradient." Further, each of claims 40, 46, 49 and 51 recite a gradient. The Office Action states that the surface described in Joyce at column 3, lines 20-44 teach such a surface. Applicant respectfully disagrees with this interpretation of Joyce. Nowhere in the cited section, nor in any other part of Joyce is a surface having uniquely coded positions arranged in a gradient taught or disclosed. Joyce, at column 3, lines 11-44, describes the surface as utilizing "an irregular spaced pattern of lines defining a rectilinear grid" and provide examples of how such a grid may be defined using lines having

different reflectivity, differing widths, irregular checkerboard patterns etc. An irregular spaced pattern is different from a gradient as recited in Applicant's claims 30 -31, 40, 46, 49 and 51. As a result, Joyce does not teach each and every element of Applicant's claims 30-31, 40, 46, 49 and 51. Applicant respectfully requests reconsideration and the withdrawal of the rejection of these claims.

Claims 41 and 42 depend from claim 40. These dependent claims inherit the elements of claim 40 and add further patentable distinctions. Applicant respectfully submits that dependent claims 41 and 42 are allowable for at least the same reasons as discussed above with respect to claim 40.

With respect to claims 46 and 49, the Office Action states without citation:

"Joyce discloses a pointing device, wherein each gradient is a color gradient (note the tablet includes a unique black and white pattern of lines forming a gradient) such that the plurality of positions uniquely vary in intensity level of color; and wherein each gradient is a gray-scale gradient such that the plurality of positions uniquely vary in shades of gray."

Applicant has search Joyce, and can find no reference to a gradient of any kind, nor can Applicant find any reference to "shades of gray". Applicant notes that providing lines of different color intensity does not necessarily mean that the lines are arranged in a gradient. As a result, Applicant respectfully submits that Joyce does not teach using a color gradient to uniquely code positions on a surface. Therefore Joyce does not teach each and every element of Applicant's claims 46 and 49 and thus does not anticipate Applicant's claims 46 and 49. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 46 and 49.

### §103 Rejection of the Claims

Claims 43-45 were rejected under 35 USC § 103(a) as being unpatentable over Joyce. In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection, because the cited reference fails to teach each and every limitation of Applicant's claims. Further, the Office Action fails to provide any reasoning as to why the claims are obvious, the Office Action merely states that the claim are obvious.

Joyce fails to teach each and every limitation of Applicant's claims 43-45. The Office Action admits that Joyce does not disclose the language recited in claims 43-45. Additionally, claims 43-45 each depend from claim 40, which recites a first and second gradient. Thus claims 43-45, through inheritance from a base claim, also include the first and second gradient. As discussed above, Joyce fails to teach or disclose a first or second gradient. Therefore Joyce fails to teach or disclose each and every element of Applicant's claims 43-45.

Additionally, the Examiner must provide a specific reason to support an obvious rejection. *Ex parte Humphreys*, 24 USPQ2d 1255 (B.P.A.I. 1992). Since the Office Action only stated that claims 43-45 were obvious and did not provide a specific reason why the claims were obvious, the Office Action has not made a *prima facie* case for obviousness with respect to claims 43-45.

For the above reasons, Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 43-45.

Claim 50 was rejected under 35 USC § 103(a) as being unpatentable over Joyce in view of Pettypiece. Applicant respectfully traverses the rejection, because neither Joyce nor Pettypiece teach or disclose each and every element of Applicant's claim 50. Claim 50 depends from claim 40, and therefore inherits the recitations of a first and second gradient that substantially cover the surface. As discussed above, Joyce does not teach a gradient of any kind, and Pettypiece does not teach a gradient that substantially covers the surface. As a result, neither Joyce nor Pettypiece teach or disclose each and every limitation (including inherited limitations) of claim 50. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 50.

Allowable Subject Matter

Applicant notes with appreciation that claims 34-38 were allowed. Additionally, claims 47-48 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As argued above, Applicant submits that claim 46, the base claim of claims 47 and 48 is allowable. Applicant therefore believes that claims 47 and 48 are allowable as written. Applicant will consider rewriting claims 47 and 49 in independent form in a future response should claim 46 be determined to be not allowable.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

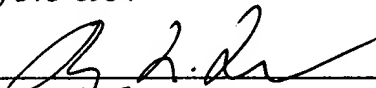
Respectfully submitted,

FRANK W. LIEBENOW

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6954

Date June 17, 2004

By   
Rodney L. Lacy  
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17<sup>th</sup> day of June, 2004.

Rodney L. Lacy  
Name

  
Signature